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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,020	03/24/2004	Dana C. Bookbinder	BOOKBINDER 16-6-1C	7849

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CORNING INCORPORATED
SP-TI-3-1
CORNING, NY 14831

EXAMINER

MOORE, MARGARET G

ART UNIT	PAPER NUMBER
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1796

MAIL DATE	DELIVERY MODE
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01/14/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/809,020

Applicant(s)

BOOKBINDER ET AL.

Examiner

Margaret G. Moore

Art Unit

1796

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34 to 50 is/are pending in the application.
- 4a) Of the above claim(s) 47, 48 and 50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34 to 46, 49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. Applicant's election of Group I in the reply filed on 11/7/07 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. As a result of this election, the application has been transferred and is currently assigned to Examiner Margaret Moore. Upon reconsideration of the claims, the new examiner determined that the following election of species requirement was necessary.

3. This application contains claims directed to the following patentably distinct species: the various silica containing articles as found in claims 46 to 48. The species are independent or distinct because each article is structurally different from the other.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 34 to 45 and 49 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

4. During a telephone conversation with Robert Carlson on 1/07/08 a provisional election was made without traverse to prosecute the invention of the fiber perform species, claim 46. Affirmation of this election must be made by applicant in replying to

this Office action. Claims 47 and 48 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. Applicants are requested to update the status of the parent application, cited on page 1 of the specification.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 34 to 45 and 49 are rejected under 35 U.S.C. 102(b) as being anticipated by Ogawa.

Ogawa teaches an optical fiber prepared from quartz (i.e. silica) and coated with a protection layer. See for instance column 1, lines 25 to 30 and column 2, lines 35 to 45. This meets the claimed silica containing article in generic claim 34. The protective layer, shown as layer 16 in Figure 3, as a self assembled monomolecular layer. This meets the requirements of claims 42 to 45, as well as claims 38 to 41. While this layer is not specifically referred to as removable, it merely needs to have the ability to be removed to meet this limitation. Note too that, since the monomolecular protective film is structurally the same as the protective layer claimed, it will inherently have the same properties and abilities as that claimed.

For claim 43, note that the silane results in a polymer network that is UV curable.

9. Claims 34 to 40, 46 and 49 are rejected under 35 U.S.C. 102(b) as being anticipated by Siegmund.

Siegmund teaches a method of making fiber optics in which a glass preform is coated with a removable protective layer. See for instance column 1, lines 40 to 45, and the abstract. This anticipates the instant claims.

Comparable to that noted supra, while Siegmund teaches that the protective material is leachable, it only needs to be able to be ablated to meet claim 36. The high borax glass layer is, in fact, able to be ablated.

10. Claims 34 to 38, 41 to 43, 45, 46 and 49 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 2-258643 (as interpreted by the English language translation).

JP 2-258643 teaches an optical fiber preform which has a peelable resin on the surface. This resin is provided to prevent the adhesion of dirt on the preform. See for instant page 5, the second full paragraph, of the English language translation, which teaches a polyacryl resin layer meeting claim 45.

Similar to that noted above, the resin layer is able to be ablated, meeting claim 36.

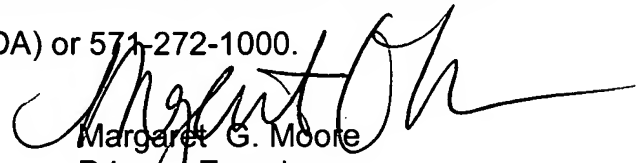
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday and Wednesday to Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Margaret G. Moore
Primary Examiner
Art Unit 1796

mgm
1/11/08